

REMARKS

Summary of the Office Action

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Publication JP-A-10-009235 to Atsuyoshi et al. ("*Atsuyoshi*") in view of JP-A-7-165256 to Seiji ("*Seiji*") and JP-A-8-199123 to Akira et al. ("*Akira*").

Summary of the Response to the Office Action

Applicant has amended claim 1. Applicant has canceled claim 10. Accordingly, claims 1-9 are presently pending.

The Rejections under 35 U.S.C. § 103(a)

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Atsuyoshi* in view of *Seiji* and *Akira*. Applicant respectfully traverses the rejections for at least the following reasons.

With respect to independent claim 1, as amended, Applicant respectfully submits that none of the applied references disclose a combination comprising a tearable film "arranged only at a portion of the staple member corresponding to an inner side of a crown portion of a C-shape staple formed from the staple member." *Seiji* and *Akira* do not disclose a staple member. Further, *Atsuyoshi*, at most, discloses a tearable film arranged on a portion of the staple member corresponding to an outer side of a crown portion of a C-shape staple. See, *Atsuyoshi*, Fig. 3.

In accordance with the feature that the tearable film is arranged "only" at a portion of the staple member corresponding to an "inner side" of a crown portion of a C-shape staple, the present invention possesses at least the following advantages over the prior art. First, the film is

not visible when sheets of paper are bound by the staple. Second, the film is not easily removed from the staple when sheets of paper are bound by the staple. Thus, the film is less likely to become adhered to the sheets of paper. Finally, the film is less likely to be removed within an electric stapler if a driver contacts the film when the staple is struck out by the driver. *See Fig. 2.* Thus, it is less likely defective operation of an electric stapler will result. Thus, Applicant respectfully asserts that the claimed configuration is novel and not merely an obvious matter of design choice.

For at least the above reasons, the Office Action has failed to establish *prima facie* obviousness. Accordingly, Applicant respectfully requests the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Further, Applicant asserts that claims 2-9 are allowable at least because of their respective dependencies from claim 1, as amended, and the reasons set forth above.

CONCLUSION

In view of the foregoing, Applicant respectfully request reconsideration of the application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response; the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under

37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Dated: September 15, 2008

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